

REMARKS

Claims 4, 7, 8, and 11-19 are pending in the present application.

At the outset, Applicants wish to thank Examiner Jones for the indication that Claims 4, 5, 7, 8, and 11-19 are allowed over Cheng et al (XP-002219274). Withdrawal of the outstanding rejections is respectfully requested in view of the following remarks.

The *provisional* obviousness-type double patenting rejections over U.S. 09/944,079 and U.S. 10/192,075, as well as the obviousness double patenting rejection over U.S. 6,458,392, are respectfully traversed.

In reviewing the Office Action it appears that the Examiner has merely restated the previous obviousness-type double patenting rejections without reviewing either the status of the applications over which the rejections have been made or the claims of those applications. Specifically, Applicants note that US Application No. 09/944,079 has been allowed and issued as US Patent No. 6,991,812. Applicants further note that the claims of the present application were amended on March 14, 2005, to exclude an ester bond from position R³. As such, the claims of US Patent No. 6,458,392, US Patent No. 6,991,812, and US Application No. 10/192,075 no longer read upon or render obvious the claims of the present application.

Much as was the case with the previous rejection over Cheng et al, the Examiner apparently attempts to overcome the deficiency in the claims of US Patent No. 6,458,392, US Patent No. 6,991,812, and US Application No. 10/192,075 by asserting "the skilled artisan would have been motivated to determine and select pharmaceutically acceptable acyl, ester, and amide moieties and derivatives with the known chlorogenic compounds." Again, even if the skilled artisan were to possess the general ability to make such a derivatization the

question that should be asked is whether the claims of US Patent No. 6,458,392, US Patent No. 6,991,812, and US Application No. 10/192,075 sufficiently disclose or suggest the same and whether such a change would be expected to produce the claimed anti-hypertensive effect.

In rejecting the claims over Cheng et al, the Examiner maintained that Solomons' represents a general motivation to convert "one carboxylic acid compound into another carboxylic acid moiety." (see page 2, lines 11-12 of the Advisory Action) The Examiner's position appears to be based on the assertion that Solomon's "clearly establishes that it is well within the level and knowledge of the artisan to convert from a chlorogenic acid as well as other caffeoylquinic acids, in particular chlorogenate, into the structurally related carboxylic acid derivatives, namely carboxylic acid ester, carboxylic acids, and carboxylic acid amines of this well known compound." (see page 2, lines 4-7 of the Advisory Action) As such, it is the Examiner's position that this general motivation would make the present invention obvious because Cheng et al already establishes that "structural analogs" are effective for treating hypertension. (see page 2, lines 7-8 of the Advisory Action)

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation... to modify the reference... Second, there must be a reasonable expectation of success. Finally, the prior art reference... must teach or suggest all the claim limitations." (MPEP §2142) However, the Examiner focused on the general ability of the skilled artisan to make the necessary modifications of the compounds disclosed by Cheng et al. However, even if the skilled artisan were to possess the *general ability* to make such a derivatization the question that the Examiner continues to ignore is whether the claims of US Patent No. 6,458,392, US Patent No. 6,991,812, and US

Application No. 10/192,075 disclose or suggest the specific modification and whether this change would be expected to produce the claimed anti-hypertensive effect.

It is well settled that whether the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness (MPEP §2143.01). To establish *prima facie* obviousness there must also be some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art (MPEP §2143.01).

In view of the foregoing arguments, the Examiner recognized the deficiency in the rejection over Cheng et al. For the same reasons, the claims of US Patent No. 6,458,392, US Patent No. 6,991,812, and US Application No. 10/192,075 fail to render the present invention obvious. Therefore, the obviousness-type double patenting rejections over US Patent No. 6,458,392, US Patent No. 6,991,812, and US Application No. 10/192,075 should be withdrawn.

Acknowledgment that these rejections have been withdrawn is requested.

The *provisional* obviousness-type double patenting rejection over U.S. 10/626,708 is respectfully traversed.

In making the rejection over US 10/626,708, the Examiner basis the same on the administration of a chlorogenic acid in Claim 6¹ of US 10/626,708 for treatment of hypertension. However, the claims are distinguishable over chlorogenic acid for the reasons set forth above. Further, Applicants note that the presently claimed invention differs from the

¹ Claim 1 of US 10/626,708 was previously canceled during prosecution of that application; however, the Examiner continues to reject the pending claims over this canceled claim.

invention claims in US 10/626,708 as this co-pending application requires the presence of one or more CNS stimulating component, whereas the presently claimed invention does not.

Moreover, Applicants note that with the amendment and remarks herein, this application should be in position for allowance. In contrast, US 10/626,708 is still being examined. Therefore, Applicants request that the Examiner withdraw the obviousness-type double patenting rejections over US Application No. 10/626,708 and permit this application to proceed to allowance.

Acknowledgment that this rejection has been withdrawn is requested.

Applicants submit that the present application is now in condition for allowance. Early notification of such action is earnestly solicited.

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